IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants:	Jay S. Walker, James A. Jorasch, Russell Sammon, Stephen Tulley, and Steven Santisi
Application No.:	10/685,143
Filed:	October 14, 2003
Title:	METHOD AND APPARATUS FOR OUTPUTTING A MESSAGE AT A GAMING MACHINE

Attorney Docket No.: 02-040

Group Art Unit:	3714
Examiner:	Leiva, Frank M.

APPEAL BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

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Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Office Action mailed March 19, 2008 (Part of Paper No./Mail Date 200880116), rejecting claims **1-6, 21-26, 36-40, 55 and 56**. This Appeal Brief is filed subsequent to a Notice of Appeal filed June 17, 2008.

TABLE OF CONTENTS

REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **7-20, 27-35, and 41-54** were previously cancelled.

Claims **1-6, 21-26, 36-40 and 55-56** are pending in the present application and are rejected.

Claims **1-6, 21-26, 36-40 and 55-56** are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Office Action mailed March 19, 2008, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed, and the dependent claims being specifically argued, are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

(i)   is by way of example of the claimed subject matter only;

(ii)   is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and

(iii)   is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims **1, 21, 36, 38, 40 and 55** are independent, and dependent claims **2-6, 22-26, 37, 39 and 56** are specifically argued.

1.   Independent Claim 1

In accordance with one or more embodiments, a method comprises *determining a message*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *identifying a game machine.* See, for example, Specification, pg. 16, line 30-page 17, line 2.

The method further provides for *determining gaming activity associated with a player.* See, for example, Specification, pg. 7, lines 5-6.

The method further provides for *determining a feature of the game machine, the feature being selected based on the gaming activity.* See, for example, Specification, pg. 7, lines 11-12; page 8, lines 10-11.

The method further provides for *wherein the feature comprises a feature that may be activated based on a selection by the player.* See, for example, Specification, pg. 44, lines 10-11.

The method further provides for *outputting the message to a player via the game machine, the message comprising a recommendation of the feature.* See, for example, Specification, pg. 120, lines 25-26; Fig. 17.

2.   Independent Claim 21

In accordance with one or more embodiments, a method comprises *determining a message.* See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a gaming activity of a player.* See, for example, Specification, pg. 7, lines 5-6.

The method further provides for *determining a feature of the game machine, the feature being selected based on the gaming activity.* See, for example, Specification, pg. 7, lines 11-12; page 8, lines 10-11.

The method further provides for *wherein the feature comprises a feature that may be activated based on a selection by the player.* See, for example, Specification, pg. 44, lines 10-11.

The method further provides for *outputting the message to a player via the game machine, the message comprising a recommendation of the feature.* See, for example, Specification, pg. 120, lines 25-26; Fig. 17.

3.   Independent Claim 36

In accordance with one or more embodiments, a method comprises *determining a message.* See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a first representation of the message and a second representation of the message.* See, for example, Specification, pg. 70, line 1-page 73, line 2.

The method further provides for *outputting the first representation of the message to a first player at a game machine.* See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *outputting the second representation of the message to a second player at a game machine.* See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player.* See, for example, Specification, pg. 71, line 31-page 72, line7.

The method further provides for *wherein determining the second representation includes selecting a representation based upon a characteristic of the second player.* See, for example, Specification, pg. 71, line 31-page 72, line7.

4.   Independent Claim 38

In accordance with one or more embodiments, a method comprises *determining a message.* See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *determining a first representation of the message and a second representation of the message.* See, for example, Specification, pg. 70, line 1-page 73, line 2.

The method further provides for *outputting the first representation of the message to a first player at a game machine.* See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *outputting the second representation of the message to a second player at a game machine.* See, for example, Specification, pg. 70, lines 4-5.

The method further provides for *wherein determining the first representation includes selecting a representation based upon an indication by the first player.* See, for example, Specification, pg. 84, line 1.

The method further provides for *wherein determining the second representation includes selecting a representation based upon an indication by the second player.* See, for example, Specification, pg. 84, line 1.

5. Independent Claim 40

In accordance with one or more embodiments, a method comprises *determining a message to be output to a player at a game machine*. See, for example, Specification, pg. 38, lines 9-10; Fig. 17.

The method further provides for *suppressing output of the message*. See, for example, Specification, pg. 7, lines 15-16, page 17, lines 6-8.

The method further provides for *wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied.* See, for example, Specification, pg. 20, lines 30-31.

6. Independent Claim 55

In accordance with one or more embodiments, a method comprises *determining an occurrence of a trigger condition.* See, for example, Specification, pg. 7, lines 1-10.

The method further provides for *identifying a message in a database of messages based on the trigger condition.* See, for example, Specification, pg. 33, line 21-pg. 34, line 2; Figs. 11A and 11B.

The method further provides for *identifying a game machine from among a plurality of game machines based on the message.* See, for example, Specification, pg. 107, line 29-pg. 108, line 6.

The method further provides for *suppressing output of the message until a second trigger condition is satisfied.* See, for example, Specification, pg. 116, lines 15-18.

The method further provides for *displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition.* See, for example, Specification, pg. 70, line 24.

The method further provides for *wherein the partition is a pop-up window.* See, for example, Specification, pg. 70, line 24.

The method further provides for *wherein the identified message includes a feature recommendation.* See, for example, Specification, pg. 120, lines 25-26, Fig. 17.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims **1-6, 21-26, and 55** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,942,574 to LeMay et al. ("LeMay" herein), or, in the alternative, as allegedly being obvious over LeMay.

Claims **36-40** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,942,574 to LeMay.

Claim **56** stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over LeMay in view of Fuchs (US 6,126,541)("Fuchs" herein).

ARGUMENTS

1.   Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

The Office Action, which is the office action the rejections of which are being appealed herein, which was mailed on March 19, 2008 as part of Paper No./Mail Date 20080116.

2.   35 U.S.C. §102(e) Rejections

Claims **1–6, 21–26, 36–40, 55 and 56** stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,942,574 to LeMay et al. ("LeMay" herein).   Appellants respectfully traverse the rejection of these claims based on the reasons presented below.

The Examiner's Section 102(e) rejections based on the above grounds are argued separately for the following appealed claims and groups of appealed claims:

- Claims **1 and 21**;
- Claims **2, 3, 4, 5 and 6**;
- Claims **22, 23, 24, 25 and 26**;
- Claim **55**;
- Claims **36, 37, 38 and 39**;
- Claim **40**.

2.1.   Claims **1 and 21**

Appellant respectfully assert that the Examiner has failed to show how the limitations of claims **1 and 21** are anticipated by or, in the alternative, are obvious over LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants respectfully assert that claims **1 and 21** recite the following limitation that is not taught or suggested by LeMay:

- *outputting the message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]* (claims **1 and 21**);

The Examiner asserted that <u>LeMay</u> discloses "Determining a message; identifying a game machine; determining gaming activity associated with a player, (col. 1:7-11, col. 3:4-7 and col. 3:21-23), allowing access to the entertainment content sources based upon the player tracking information. Determining a feature of the game machine, the feature being selected based on the gaming activity, (col. 3:20-23), the feature selectable based on the player tracking information. Wherein the feature comprises a feature that may be activated based on a selection by the player; (col. 3:7-10), whereas the system receives input of the selection from the player. Outputting the message to a player via the game machine, the message comprising a recommendation of the feature, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature. Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of the applicants invention to interpret an advise of cost as recommendations regarding the feature, one is to include that recommendations may vary according to the nature of the selected video feature, as for example the video presentation may have several different price ranges depending of the media or specific Network channel selected." (<u>Office Action</u>, page 3, section 4).

With reference to the Examiner's citations, <u>LeMay</u> states, at col. 3, lines 4-23, the following:

Another aspect of the present invention enables a method of providing entertainment content on a gaming machine providing game outcome presentations for one or more games. The method may be characterized as including: 1) displaying a list of one or more entertainment content sources, 2) receiving a selection of the entertainment content source from said list and 3) outputting the entertainment content from the selected entertainment content source to an output device, where the entertainment content is independent of the game outcome presentation for the one or more games. Additionally, the method may include, a) prior to outputting the entertainment content, determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount and c) initiating the selected entertainment content when the required indicia of credit amount is available on the gaming machine or i) prior to receiving the selection, receiving player tracking information and ii) allowing access to the entertainment content sources based upon the player tracking information.

Appellants respectfully assert that it is evident from the recited passage above that LeMay merely describes providing *access* to particular content or a content source based on certain information (e.g., a player identifier). However, LeMay is completely devoid of any description of *recommending* a feature of a gaming device. Providing access to content or a content source by making it available to a player is different from recommending content or a content source, much less from recommending a feature of a game machine.

Appellants further respectfully assert that the Examiner is in error when characterizing the teachings of LeMay. Specifically, the Examiner is in error when stating that "Outputting the message to a player via the game machine, the message comprising a recommendation of the feature, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature." Appellants simply note that "displaying a message on the display device notifying a player of the

required indicia of credit amount" is in no way, shape, or form the equivalent of outputting a *message comprising a recommendation of the feature* as recited in claims **1 and 21**. A notification of the cost of anything is most emphatically not a recommendation. In the particular instance of the teachings of LeMay, assuming, arguendo, that the selected entertainment content source is the equivalent of the claimed "feature", LeMay's message indicating the required indicia of credit amount is displayed only *after* a player has selected the so called "feature". Simply put, while the displayed indicia of LeMay is clearly not a recommendation of the "feature", it strains credulity to interpret anything as a recommendation to select something that is displayed only after the selection has been made. It is therefore evident that LeMay does not teach outputting a *message comprising a recommendation of the feature* as recited in claims **1 and 21**

   The Examiner is further in error when asserting that "Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of the applicants invention to interpret an advise of cost as recommendations regarding the feature". First, it is most certainly not inherent in the teachings of LeMay to output a *message comprising a recommendation of the feature.* That is to say, outputting a *message comprising a recommendation of the feature* does not necessarily flow from any aspect of the teachings of LeMay. Second, contrary to the Examiner's assertions, there is nothing in the teachings of Lemay that would suggest to one of skill in the art to substitute a recommendation of a feature for a cost of entertainment content in a message. As noted above, the message of LeMay is displayed after the selection of the content. As it does not make sense to recommend a feature after the feature has been selected, it would certainly not be obvious to do so.

In the <u>Response to Arguments</u> section of the <u>Office Action</u>, the Examiner asserted:

> 20.   Regarding the argument directed to LeMay's teachings of claim 1 (page 16) and claim 21 … the examiner points to Lemay (col. 3:14-19) "Additionally, the method may include, a) prior to outputting the entertainment content, determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount", the system acknowledges the players choice and advices (i.e. recommends) the feature requires additional payment.

Appellants simply note that, advising a player that a feature has an associated cost is not equivalent to recommending the feature.

For all of these reasons, it is clear that <u>LeMay</u> fails to teach or otherwise suggest *outputting a message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]* as recited in claims **1 and 21**. As a result, the rejections of claims **1 and 21** must be withdrawn.

2.2   <u>Claims 2, 3, 4, 5 and 6</u>

Appellant respectfully assert that the Examiner has failed to show how the limitations of claims **2, 3, 4, 5 and 6** are taught or otherwise suggested by <u>LeMay</u>. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Dependent claims **2, 3, 4, 5 and 6** recite the following claim limitations that are not taught or suggested by <u>LeMay</u>:

- *wherein determining the message includes determining a status message.* (claim **2**);
- *wherein determining the message includes determining an instructive message.* (claim **3**);
- *wherein determining the message includes determining a communication message.* (claim **4**);
- *wherein determining the message includes determining a promotional message.* (claim **5**);
- *wherein determining the message includes determining an activity-benefit offer.* (claim **6**).

The Examiner asserted that "**Regarding claims 2 and 22**; LeMay discloses; wherein determining the message includes determining a status message, (col. 5:41-47). 6. **Regarding claims 3and 23**; LeMay discloses: wherein determining the message includes determining an instructive message, (3:14-19). 7. **Regarding claims 4 and 24**; LeMay discloses: wherein determining the message includes determining a communication message, (5:41-47). 8. **Regarding claims 5 and 25**; LeMay discloses: wherein determining the message includes determining a promotional message. (col. 2:15-29). 9. **Regarding claims 6 and 26**; LeMay discloses: wherein determining the message includes determining an activity-benefit offer, (col. 3:55-60)." (<u>Office Action</u>, pages 3- 4).

Appellants note that, as all of claims **2-6** depend upon claim **1** and include all of the limitations and elements of claim **1**, for the reasons discussed above in section 2.1 with regards to claim **1**, the rejections of all of claims **2-6** must be withdrawn.

Furthermore, as has already been established in section 2.1, <u>LeMay</u> does not teach or suggest *outputting a message to a player via the game machine, the message comprising a recommendation of the feature* as recited in claim **1**. It is therefore axiomatic that, as <u>LeMay</u> does not teach outputting such a message, <u>LeMay</u> does not teach outputting such a message having an additional attribute.

Quite simply, Appellants assert that <u>LeMay</u> does not teach or suggest a message *comprising a recommendation of the feature [of the game machine]* wherein the message additionally and alternatively includes a status message, an instructive message, a communication message, a promotional message, and an activity-benefit offer as recited in claim **2, 3, 4, 5 and 6**, respectively.

For these additional reasons, the rejections of all of claims **2-6** must be withdrawn.

2.3   **Claims 22, 23,24, 25 and 26**

Appellant respectfully assert that the Examiner has failed to show how the limitations of claims **22, 23, 24, 25 and 26** are taught or otherwise suggested by <u>LeMay</u>. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Dependent claims **22, 23, 24, 25 and 26** recite the following claim limitations that are not taught or suggested by <u>LeMay</u>:

- *wherein determining the message includes determining a status message.* (claim **22**);

- *wherein determining the message includes determining an instructive message.* (claim **23**);

- *wherein determining the message includes determining a communication message.* (claim **24**);

- *wherein determining the message includes determining a promotional message.* (claim **25**);

- *wherein determining the message includes determining an activity-benefit offer.* (claim **26**).

The Examiner asserted that "**Regarding claims 2 and 22**; LeMay discloses; wherein determining the message includes determining a status message, (col. 5:41-47). 6. **Regarding claims 3and 23**; LeMay discloses: wherein determining the message includes determining an instructive message, (3:14-19). 7. **Regarding claims 4 and 24**; LeMay discloses: wherein determining the message includes determining a communication message, (5:41-47). 8. **Regarding claims 5 and 25**; LeMay discloses: wherein determining the message includes determining a promotional message. (col. 2:15-29). 9. **Regarding claims 6 and 26**; LeMay discloses: wherein determining the message includes determining an activity-benefit offer, (col. 3:55-60)." (<u>Office Action</u>, pages 3- 4).

Appellants note that, as all of claims **22-26** depend upon claim **21** and include all of the limitations and elements of claim **21**, for the reasons discussed

above in section 2.1 with regards to claim **21**, the rejections of all of claims **22-26** must be withdrawn.

Furthermore, Appellants assert that the Examiner has failed to establish a *prima facie* case for anticipation of claims **22-26**. As has already been established in section 2.1, <u>LeMay</u> does not teach or suggest *outputting the message to the player via the game machine, the message comprising a recommendation of the feature* as recited in claim **21**. It is therefore axiomatic that, as <u>LeMay</u> does not teach outputting such a message, <u>LeMay</u> does not teach outputting such a message having an additional attribute.

Quite simply, Appellants assert that <u>LeMay</u> does not teach or suggest a message *comprising a recommendation of the feature [of the game machine]* wherein the message additionally and alternatively includes a status message, an instructive message, a communication message, a promotional message, and an activity-benefit offer as recited in claim **22, 23, 24, 25 and 26**, respectively.

For these additional reasons, the rejections of all of claims **22-26** must be withdrawn.

2.4   **Claim 55**

Appellants respectfully assert that the Examiner has failed to show how the limitations of claim **55** are taught or otherwise suggested by <u>LeMay</u>. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim **55** recites the following limitation that is not taught or suggested by <u>LeMay</u>:

- *suppressing output of the message until a second trigger condition is satisfied.*

Regarding claim **55**, the Examiner asserted that <u>LeMay</u> discloses "Determining an occurrence of a trigger condition; identifying a game machine from among a plurality of game machines based on the message; suppressing output of the message until a second trigger condition is satisfied; and displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition, (col. 3:4-23), whereas the system provides game outcome presentations for one or more games, (i.e. is triggered to send updates of games that the player has selected to track) it has to track the movement of the player on the floor to deliver messages, and the player has to pay or have enough play history to be able to receive the content (i.e. second trigger is payment). Wherein the partition is a pop-up window, and (figure 2(item 275 and 257)). Wherein the identified message includes a feature recommendation, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature". (<u>Office Action</u>, page 4).

Appellants have reviewed the entirety of <u>LeMay</u>, and specifically the Examiner's citation to col. 3:4-23 (reproduced in its entirety above) and have been unable to find any description remotely related to, teaching, or suggestive of the following elements of claim **55**:

- *identifying a message in a database of messages based on the trigger condition;*
- *identifying a game machine from among a plurality of game machines based on the message;*
- *suppressing output of the message until a second trigger condition is satisfied;* and
- *displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition, wherein the partition is a pop-up window, and wherein the identified message includes a feature recommendation.*

Appellants respectfully assert that, first, LeMay makes no mention, at the Examiner's citation or elsewhere, of *identifying a message in a database of messages based on the trigger condition* or *identifying a game machine from among a plurality of game machines based on the message* as recited in claim **55**.

Second, assuming, arguendo, that LeMay were to teach or otherwise suggest a message including a feature recommendation, such a message is most assuredly not displayed *upon satisfaction of the second trigger condition* as asserted by the Examiner. Specifically, the Examiner asserts that the "second trigger is payment". This assertion gives rise to numerous logical impossibilities. Specifically, according to claim **55**, the identified message is displayed upon satisfaction of the second trigger condition. Assuming, arguendo, as the Examiner does, that the second trigger is payment by the player and that the message is a message "advising of the cost of the feature" then Lemay would have to teach receiving payment for a feature from a player before informing the player of the need to pay for the feature and displaying a message to the player indicating the cost of the

feature after the player has already paid. Appellants respectfully assert that LeMay, contrary to the Examiner's assertions, teaches no such thing.

For all of these reasons, the rejection of claim **55** must be withdrawn.

2.5   Claims 36, 37, 38 and 39

Appellants respectfully assert that the Examiner has failed to show how the limitations of claims **36** and **38** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellants respectfully assert that claims **36 and 38** recite the following limitations that are not taught or suggested by LeMay:

- *determining a first representation of the message and a second representation of the message;*
- *outputting the first representation of the message to a first player at a game machine;*
- *outputting the second representation of the message to a second player at a game machine;*

The Examiner asserted "**Regarding claims 36 and 38;** LeMay discloses … Determining a message; determining a first representation of the message and a

second representation of the message; outputting the first representation of the

message to a first player at a game machine; and outputting the second

representation of the message to a second player at a game machine, (col. 4:61-67),

similar content as presented in TV format is available in WEB page format so that

two players can view content in two different formats. Wherein determining the

first representation includes selecting a representation based upon a characteristic

of the first player, and wherein determining the second representation includes

selecting a representation based upon a characteristic of the second player, (col.

4:66-67), upon the player tracking information, player preferences are kept for

those more sophisticated players, the content will be sent in their preferred

format." (Office Action, page 5, section 13).

In fact, the sum total of all that LeMay teaches and to which the Examiner

refers to with references to all of the elements of claims **36 and 38**, at col. 4, lines

61-67, is the following:

> Also, the television programming entertainment content may be
> displayed while a player is engaged in playing a game on the gaming
> machine or between games. Similarly, the entertainment content may
> include information available on the Internet, including the World
> Wide Web, for more technologically sophisticated players.

As is evident, there is no teaching or suggestion of *determining a first

representation of the message and a second representation of the message* as

recited in claims **36 and 38**. Rather, LeMay teaches displaying entertainment

content that may comprise either television programming or internet content.

There is no teaching or suggestion that these widely disparate and unrelated forms

of content are in any way two representations of a single message. Furthermore,

were there to be taught two such representations of a message as claimed (and

- 27 -

Appellants respectfully reiterate that there is not so taught) there is no mention, teaching, or suggestion of *outputting the first representation of the message to a first player at a game machine* or *outputting the second representation of the message to a second player at a game machine* as claimed.

Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim **36**:

- *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player.*

Contrary to the Examiner's assertion, the mere mention by LeMay that "content may include information available on the Internet, including the World Wide Web, for more technologically sophisticated players" does not in any way teach that a first representation of a message is selected based upon a characteristic of a first player and that a second representation of a message is selected based upon a characteristic of a second player. As is evident, LeMay does not teach any first and second representation of a message for output to any player, much less for output to a first and a second player, much less where the two representations are each selected for either player based upon a characteristic of each player.

Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim **38**:

- *wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player.*

Appellants merely assert that, as <u>LeMay</u> does not teach or otherwise suggest *determining a first representation of the message and a second representation of the message,* it logically follows that <u>LeMay</u> does not further teach or suggest *wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player* as recited in claim **38**.

For all of these reasons, the rejections of claims **36 and 38** must be withdrawn.

Appellants further note that the Examiner asserted that **"Regarding claims 37 and 39**: LeMay discloses wherein the first representation is different from the second representation, (col. 4:64-67). Whereas different media are considered different representations"** (<u>Office Action</u>, page 6).

Appellants merely note that claim **37** depends upon claim **36** and includes all of the limitations of claim **36**. For this reason alone, the rejection of claim **37** must be withdrawn. In addition, Applicants assert that, as <u>LeMay</u> does not disclose a first and second representation of a message, it is axiomatic that <u>LeMay</u> does not teach or otherwise disclose *wherein the first representation is different from the second representation* as recited in claim **37**. Furthermore, while in some circumstances different media can be considered different representations, differing media are not, ipso facto, different representations of the same message.

- 29 –

For example, a displayed episode of a television show and an unrelated internet slide show are both different media and different representations, however, they are not different representations of the same element, in particular, different representations of the same message as claimed. For these additional reasons, the rejection of claims **37** must be withdrawn.

With respect to claim **39**, Appellants merely note that claim **39** depends upon claim **38** and includes all of the limitations of claim **38**. For this reason alone, the rejection of claim **38** must be withdrawn. In addition, Applicants assert that, as LeMay does not disclose a first and second representation of a message, it is axiomatic that LeMay does not teach or otherwise disclose *wherein the first representation is different from the second representation* as recited in claim **39**. For this additional reason, as well as the reasons discussed above with reference to claim **37**, the rejection of claim **39** must be withdrawn.

2.6   Claim 40

Appellants respectfully assert that the Examiner has failed to show how the limitations of claim **40** are taught or otherwise suggested by LeMay. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim **40** recites the following limitation that is not taught or suggested by LeMay:

■ *suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied*

With respect to claim **40**, the Examiner asserted that <u>LeMay</u> discloses "wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied, (col. 3:14-23), prior to outputting the message, the system holds the information till it confirms that the credits indicia is paid (trigger event), thus the message is already created and waiting for the player to satisfy a condition before sending." (<u>Office Action</u>, page 6).

Appellants reassert, as explained more fully in section 2.4 above that the Examiner's assertions suffer from a lack of adherence to the realm of that which is logically possible. Assuming, arguendo, as the Examiner does, that the trigger is payment by the player and that the message is a message "advising of the cost of the feature" then <u>Lemay</u> would have to teach receiving payment for a feature from a player before informing the player of the need to pay for the feature and displaying a message to the player indicating the cost of the feature after the player has already paid. Appellants respectfully assert that <u>LeMay</u>, contrary to the Examiner's assertions, teaches no such thing. Furthermore, as is evident from even a cursory reading of the citation of the Examiner, <u>LeMay</u> does not teach the suppression of any message for any reason based upon any condition. Rather, <u>LeMay</u> states, in toto, "displaying a message on the display device notifying a player of the required indicia of credit amount." No trigger condition. No suppressing.

For all of these reasons, the rejection of claim **40** must be withdrawn.

3.   35 U.S.C. §103(a) Rejections

Claim **56** stands rejected under 35 U.S.C. 103(a) as being unpatentable over
LeMay in view of <u>Fuchs</u>.   Appellants respectfully traverse the rejection of these
claims based on the reasons presented below.

3.1   **Claim 56**

Appellants respectfully assert that the Examiner has failed to show how the
limitations of claim **56** are taught or otherwise suggested by the combination of
LeMay as applied to claim 1 in further view of Fuchs (US 6,126,541). As is
clearly stated at MPEP §2143 "To establish a *prima facie* case of obviousness,
three basic criteria must be met. First, there must be some suggestion or
motivation, either in the references themselves or in the knowledge generally
available to one of ordinary skill in the art, to modify the reference or to combine
reference teachings. Second, there must be a reasonable expectation of success.
Finally, **the prior art reference (or references when combined) must teach or
suggest all the claim limitations.** (emphasis added).

Dependent claim **56** recites the following claim limitation that is not taught
or suggested by the combination of <u>LeMay</u> and <u>Fuchs</u>, such a combination neither
suggested nor deemed appropriate:

- *data indicating how a result of the gaming activity would have been
  different if the recommended feature had been activated during the
  gaming activity.*

The Examiner asserted that "Regarding Claim 56: LeMay discloses the method of claim 1 but does not discloses how the result of the selection would have been different otherwise selected. Fuchs discloses wherein the message further comprises data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity, (col. 6:16-39)." (Office Action, page 7).

Appellants respectfully assert that, contrary to the Examiner's assertion, Fuchs does not teach *data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity* as claimed.

In fact, at the Examiner's citation to col. 6:16-39 , Fuchs states:

> At the same time that the machine displays these game symbols 3, which are statistically or randomly selected by the computer unit 5, or after a call-up button 14 is activated by the player, the computing unit 5 indicates in the winning chances display 7 the chances of winning which are readily achievable if the player actually stores certain game symbols 3' which the computer unit 5 has judged to be advantageous for the next game. In the present case, since it is a type of poker game that is being played, the computer unit 5 has suggested that two game symbols 3', namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces, and these possible ways of winning are assigned various prize values in the display fields 21. In addition to the display panels 21 indicating the amount of the attainable prizes or combinations of prizes, it is also possible to offer the player a display 20 showing the probability with which the given combinations of game symbols or the prizes are likely to be attained. For this purpose, at least one display panel 20 is arranged in the winning chances display area 7 to indicate the likelihood, expressed in percentage terms or the probability with which an indicated combination of game symbols or an offered possibility of winning can be realized.

As is evident, <u>Fuchs</u> merely teaches informing a player of various probabilities related to future events that may be attained. Such information is prospective and is, quite obviously, not definitive. In contrast, claim **56** recites a message comprising *data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity.* Note that such data is backwards looking, (i.e., what would have happened) and is definitive. It is clear, therefore, that <u>Fuchs</u> does not teach or otherwise suggest, *data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity* as claimed. As a result, the combination of the teachings of <u>LeMay</u> and <u>Fuchs</u>, such a combination neither suggested nor deemed appropriate, likewise fails to teach the recited elements of claim **56**. For all of these reasons, the rejection of claim **56** must be withdrawn.

CONCLUSION

Thus, the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be withdrawn.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jeffrey R. Ambroziak, at telephone number 203-461-7317 or via electronic mail at jambroziak@walkerdigital.com.

Appellants believe that this Appeal Brief is filed within one month of the statutory time within which to respond. Accordingly, filed herewith is a petition for a one month extension of time as well as the attendant fees. However, if an additional fee should be due, please charge such fees to our <u>Deposit Account No. 50-0271</u>.

September 17, 2008
Date

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APPENDIX A - CLAIMS INVOLVED IN THE APPEAL

1.   A method, comprising:

determining a message;

identifying a game machine;

determining gaming activity associated with a player;

determining a feature of the game machine, the feature being selected based on the gaming activity,

wherein the feature comprises a feature that may be activated based on a selection by the player; and

outputting the message to a player via the game machine, the message comprising a recommendation of the feature.

2.   The method of claim 1 wherein determining the message includes determining a status message.

3.   The method of claim 1 wherein determining the message includes determining an instructive message.

4.   The method of claim 1 wherein determining the message includes determining a communication message.

5.   The method of claim 1 wherein determining the message includes determining a promotional message.

6.   The method of claim 1 wherein determining the message includes determining an activity-benefit offer.

21.   A method, comprising:

determining a message;

determining a gaming activity of a player;

determining a feature of a game machine, the feature being selected based on the gaming activity,

wherein the feature comprises a feature that may be activated based on a selection by the player; and

outputting the message to the player via the game machine, the message comprising a recommendation of the feature.

22.   The method of claim 21 wherein determining the message includes determining a status message.

23.   The method of claim 21 wherein determining the message includes determining an instructive message.

24.   The method of claim 21 wherein determining the message includes determining a communication message.

25.   The method of claim 21 wherein determining the message includes determining a promotional message.

26.   The method of claim 21 wherein determining the message includes determining an activity-benefit offer.

36.   A method, comprising:

determining a message;

determining a first representation of the message and a second representation of the message;

outputting the first representation of the message to a first player at a game machine; and

outputting the second representation of the message to a second player at a game machine;

wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and

wherein determining the second representation includes selecting a representation based upon a characteristic of the second player.

37.   The method of claim 36 wherein the first representation is different from the second representation.

38.   A method, comprising:

     determining a message;

     determining a first representation of the message and a second representation of the message;

     outputting the first representation of the message to a first player at a game machine; and

     outputting the second representation of the message to a second player at a game machine;

     wherein determining the first representation includes selecting a representation based upon an indication by the first player, and

     wherein determining the second representation includes selecting a representation based upon an indication by the second player.

39.   The method of claim 38 wherein the first representation is different from the second representation.

40.   A method, comprising:

     determining a message to be output to a player at a game machine; and

     suppressing output of the message,

     wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied.

55.   A method, comprising:

determining an occurrence of a trigger condition;

identifying a message in a database of messages based on the trigger
condition;

identifying a game machine from among a plurality of game machines based
on the message;

suppressing output of the message until a second trigger condition is
satisfied; and

displaying the identified message in a partition on the identified game
machine upon satisfaction of the second trigger condition,

wherein the partition is a pop-up window, and

wherein the identified message includes a feature recommendation.

56.   The method of claim 1, wherein the message further comprises:

data indicating how a result of the gaming activity would have been different
if the recommended feature had been activated during the gaming activity.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>